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Pinchas Shalev

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P.O. Box 16446

Arlington, VA 22215

EXAMINER

RALIS, STEPHEN J

ART UNIT

PAPER NUMBER

3742

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,747	<b>Applicant(s)</b> SHALEV ET AL.	
	<b>Examiner</b> STEPHEN J. RALIS	<b>Art Unit</b> 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/15/2009 and 5/26/2009</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicant is respectfully requested to provide a location within the disclosure to support any further amendments to the claims due to when filing an amendment an applicant should show support in the original disclosure for new or amended claims. See MPEP § 714.02 and § 2163.06 ("Applicant should specifically point out the support for any amendments made to the disclosure.").

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 May 2009 has been entered.

***Response to Amendment/Arguments***

4. Applicant's arguments filed 15 April 2009 have been fully considered but they are not persuasive as set forth below.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-13 and 16-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, the examiner can find no disclosure to the embodiment with a blade having a wire that "is positioned such that it may touch the skin during operation". The examiner can find only disclosure to the wire performing certain functions when being utilized in conjunction with a blade (page 14, line 28 – page 12, line 8). The examiner finds disclosure to the heating wire contacting the skin in an embodiment in which the heating wire is utilized for shaving (see Figure 4), however, the disclosure is silent to the exact position of the heating wire with respect to the skin in the blade embodiment/configuration (see Figure 6C). Therefore, the recitation to "the wire is positioned such that it may touch the skin during operation" is deemed new matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-13 and 16-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Claims 1 and 13 recite the limitation "the wire is positioned such that it may touch the skin during operation". The recitation to "such that it may..." is deemed unclear and indefinite since it is neither a positive or negative limitation and it is vague to whether the heating element actually touches the skin or does not. Further clarification is required to provide clear and concise recitation to the structure/functionality.

Claim 1 recites the limitation "the heated wire" in line 4; the limitation "the wire" in lines 5-8; Claims 4-12, 16-22, 24-29 recite the limitation "said/the wire" Claim 23 recites the limitation "the heated wire" in lines 1-2. There is insufficient antecedent basis for these limitation in the claims.

In general, the claims are replete with such 35 U.S.C. 112, second paragraph issues. The above notes are exemplary with respect to all of the 35 U.S.C. 112, second paragraph rejections present in the instant case, all claims must be carefully reviewed and appropriate corrections should be made in response to this rejection.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1, 5-11, 13 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solvinto (French Publication No. FR 2532878 A) in view of Warden et al. (U.S. Patent No. 7,048,746).

Solvinto discloses a hair cutting head for use in a hair cutting apparatus and a method of cutting hair growing from the skin (see Figures 1-7), comprising: an elongated heated wire (heated metal wire or strip; Abstract) suitable for heating hair growing from a skin surface (Abstract); and at least one blade (one cutting blade), placed at one side of the elongated heated wire (one blade carrying a metal wire or strip; Abstract), the at least one blade being situated and configured to cut the hair

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which has been heated by the heated wire, wherein the wire is heated to a temperature of at least 50°C (heated between 700 and 1000 °C; Abstract).

With respect to the limitation of “at least one blade, placed at one side of the elongated heated wire, the at least one blade being situated and configured to cut the hair which has been heated by the heated wire”, Solvinto explicitly teaches a clamping blade and a cutting blade. The cutting blade has, thereon, a heating element placed within a slot on the blade itself (page 10, bottom – page 11, line 4). Therefore since Solvinto discloses a cutting blade and a clamping blade with the cutting blade having a heating wire (metallic wire 4) placed at one side of the blade and the cutting blade with the heating wire (metallic wire 4) being situated in the apparatus for explicitly cutting hair which has been heated by the heated wire (metallic wire 4), Solvinto fully meets “at least one blade, placed at one side of the elongated heated wire, the at least one blade being situated and configured to cut the hair which has been heated by the heated wire” given its broadest reasonable interpretation.

With respect to the limitation of the wire being positioned “such that it may touch the skin during operation”, the limitation is being deemed functional language. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In addition, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim (see MPEP § 2114). In that regard, Solvinto

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teaches all the structural limitations, as set forth above, and is deemed to have a wire that is positioned on the apparatus in a position that may touch the skin during operation given its broadest reasonable interpretation.

With respect to the limitations of claim 5, Solvinto further discloses the elongated heated wire (heated metal wire or strip; Abstract) being heated to a temperature between 700 and 1000 °C when the apparatus is brought into contact with a skin surface to cut hair (Abstract). Therefore, Solvinto fully meets “wherein said wire is heated when said cutting head comes in contact with a skin surface” given its broadest reasonable interpretation.

In addition, Solvinto discloses the wire being in the range of 0.1 and 0.8 mm (page 5-6; English translation) as well as the metal wire or blade being electrically heated by alternating current or from a battery.

Solvinto discloses all of the limitations of the claimed invention, as previously set forth, except for burning of the skin being prevented by one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected.

However, burning of the skin being prevented by one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected is known in the art. Warden et al., for example, teach a heating filament (15) in which power is pulsed or supplied for a brief period to heat the heating filament (15). Warden et al. further teach the advantage of such a configuration does not provide discomfort to a patient during



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use (column 5, lines 10-18), thereby increasing the operational efficiency of the device. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Solvinto with the power that is pulsed of Warden et al. in order to provide a means does not provide discomfort to a patient during use, thereby increasing the operational efficiency of the device.

14. Claims 1, 5-13 and 16-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Iderosa (U.S. Patent No. 5,065,515) in view of Solvinto (French Publication No. FR 2532878 A), Ringler et al. (U.S. Patent No. 20020151881) and Warden et al. (U.S. Patent No. 7,048,746).

Iderosa discloses a hair cutting head for use in a hair cutting apparatus and a method of cutting hair growing from the skin, (see Figure 3), (shaving system; Title) comprising: an elongated heated wire (heating element 15) suitable for heating hair growing from a skin surface (column 3, line 52 - column 4, line 18); and at least one blade (46), placed at one side of the elongated heated wire (heating element 15) (see Figure 3), the at least one blade (46) being situated and configured to cut the hair which has been heated by the heated wire (heating element 15; column 3, line 52 - column 4, line 18; column 6, lines 28-44).

With respect to the limitation of the wire being positioned "such that it may touch the skin during operation", the limitation is being deemed functional language. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure

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rather than function. In addition, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (see MPEP § 2114). In addition, applicant has disclosed that Iderosa is permanently in contact with the skin (page 1- lines 25-28). In that regard, Iderosa teaches all the structural limitations, as set forth above, and is deemed to have a wire that is positioned on the apparatus in a position that may touch the skin during operation given its broadest reasonable interpretation.

With respect to the limitations of claim 5, Iderosa discloses the elongated heated wire (heating element 15) being heated to a temperature sufficient to soften hair when the apparatus is brought into contact with a skin surface (column 3, line 52 - column 4, line 18; column 6, lines 28-44). Therefore, Iderosa fully meets "wherein said wire is heated when said cutting head comes in contact with a skin surface" given its broadest reasonable interpretation.

With respect to the limitations of claim 22, Iderosa discloses the elongated heated wire (heating element 15) and blade (46) being in a "side-by-side" configuration (see Figure 3). Therefore, Iderosa fully meets "including juxtaposing the wire and the blade in a generally parallel configuration" given its broadest reasonable interpretation.

With respect to the limitations of claim 23, Iderosa discloses the method including first moving the heated wire (heating element 15) and then the blade (46) across the skin (see arrow 38 in Figure 3; column 3, line 52 - column 4, line 18; column 6, lines 28-44).

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With respect to the limitations of claims 24 and 25, Iderosa discloses the elongated heated wire (heating element 15) preheating (Abstract) and softening the hair (column 3, line 52 - column 4, line 18; column 6, lines 28-44) and the blade (46) being used to cut the hair.

Iderosa discloses all of the limitations of the claimed invention, as previously set forth, except for the wire being heated to a temperature of at least 50°C, a temperature higher than 100°C, a temperature higher than 150°C, a temperature higher than 250°C, a temperature higher than 350°C, a temperature higher than 500°C, or a temperature higher than 700°C; and burning of the skin being prevented by to one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected.

However heating a piece of hair to at least 50°C, a temperature higher than 100°C, a temperature higher than 150°C, a temperature higher than 250°C, a temperature higher than 350°C, a temperature higher than 500°C, or a temperature higher than 700°C is known in the art. Solvinto, for example, teaches a cutting apparatus having one blade carrying a metal wire or strip which is heated to a temperature of between 700 and 1000 °C. Solvinto also discloses the wire being in the range of 0.1 and 0.8 mm (page 5-6; English translation) as well as the metal wire or blade being electrically heated by alternating current or from a battery. In addition, Ringler et al. teach a heating element that is heated to a temperature of from about 400 to about 1000°F (equivalency being from about 204.4 to about 537°C) (Abstract; page 2, paragraph 27; page 4, paragraph 48, pages 4-5, claims 2-4, 17-19). Ringler et al.

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further teach the advantage such a configuration provides a means to heating a hair follicle to such a temperature for fusing and sealing the cuticle, cortex and medulla layers of the hair shaft.

Similarly, burning of the skin being prevented by to one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected is known in the art. Warden et al., for example, teach a heating filament (15) in which power is pulsed or supplied for a brief period to heat the heating filament (15). Warden et al. further teach the advantage of such a configuration does not provide discomfort to a patient during use (column 5, lines 10-18), thereby increasing the operational efficiency of the device.

Therefore, in view of Solvinto, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the heating element of Iderosa with the carrying a metal wire or strip which is heated to a temperature of between 700 and 1000 °C, since as evidenced by Ringler et al., such a temperature range provides a means to heating a hair follicle to such a temperature for fusing and sealing the cuticle, cortex and medulla layers of the hair shaft, thereby increasing the efficiency of the hair cutting apparatus. Similarly, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Solvinto with the power that is pulsed of Warden et al. in order to provide a means does not provide discomfort to a patient during use, thereby increasing the operational efficiency of the device.

With respect to the limitations of claim 12, Iderosa discloses the heating element (15) heating to a temperature sufficient to soften hair before the hair is cut by the blade

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(46). Solvinto, as evidenced by Ringler et al., teach a temperature that is associated with cutting hair in order to completely fuse and seal and hair follicle. It is known in the art that hair tends to typically be substantially in the range 100 microns. However, it is physically impossible for all of the hair follicles to be equivalent in thickness. Therefore since some of the relatively thin hair follicles would be not only be softened but would potentially be cut in lieu of the temperature ranges taught by Solvinto and Ringler et al., it is deemed that Iderosa in view of Solvinto and Ringer et al. would provide a wire heated to a temperature high enough to at least cut some of the relatively thin hairs. Therefore, Iderosa in view of Solvinto and Ringer et al. fully meets "said wire is heated to a temperature high enough so that it cuts at least some of the hair before the hair comes into contact with said blade, when the heated wire and blade are drawn across the skin" given its broadest reasonable interpretation.

15. Claims 2-4 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iderosa (U.S. Patent No. 5,065,515) in view of Solvinto (French Publication No. FR 2532878 A), Ringler et al. (U.S. Patent No. 20020151881) and Warden et al. (U.S. Patent No. 7,048,746) as applied to claims 1, 5-13 and 16-25 above, and further in view of Hashimoto (U.S. Patent No. 6,043,457).

With respect to the limitations of claims 28 and 29, Iderosa discloses the elongated heated wire (heating element 15) being heated to a temperature sufficient to soften hair when the apparatus is brought into contact with a skin surface (column 3, line 52 - column 4, line 18; column 6, lines 28-44). Therefore, Iderosa fully meets

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“wherein said wire is heated when said cutting head comes in contact with a skin surface” given its broadest reasonable interpretation.

Iderosa in view of Solvinto, Ringler et al. and Warden et al. discloses all of the claimed limitations, as previously set forth, except for a row of skin depressing elements on at least one side of the elongated heated wire or a row of skin depressing elements on both sides of the elongated heated wire; and the wire having a diameter between 10 to 1000 micrometers.

However, a pair of equally spaced skin depressing elements comprising rows of skin depressing side elements on each side of the heat generator, as described by, Hashimoto, is known in the art. Hashimoto, for example, teaches opposed comb tooth plates (3, 3) to provide improved and easy access of hair entering the hair singing device, while not affecting or removing the required safety buffer between the user and the heating wire. In addition, Hashimoto teaches a heating element (13a) comprising a heating wire (13aa) made of nichrome fine wire having a diameter in the range of 0.1 to 0.14 mm (equivalency being 100 to 140  $\mu\text{m}$ ). Furthermore, Iderosa teaches the advantage of a thinner, beveled and rounder portion of the heating element is relatively electrically more resistive than other thicker portions or even elements, thereby dissipating relatively more heat.

In view of Hashimoto, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the guard elements have comb teeth to provide improved and easy access of hair entering the hair singing device, while not affecting or removing the required safety buffer between the user and the heating wire. It would

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have further been obvious to one of ordinary skill in the art at the time of the invention was made to modify Iderosa in view of Solvinto, Ringler et al. and Warden et al. with the wire having a diameter between 10 to 1000 micrometers of Hashimoto, since as evidenced by Iderosa, such a thinner, beveled and rounder portion of the heating element is relatively electrically more resistive than other thicker portions or even elements, thereby dissipating relatively more heat.

### ***Remarks***

16. With respect to applicant's reply/argument in regard to the finality of the previous Office action, the examiner respectfully disagrees. Applicant asserted in the reply/arguments, filed 15 April 2009, that the Office action should not be made final because: "A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." (See MPEP § 703.07(a)). The examiner, for the record, asserts that "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)" ((see MPEP § 703.07(a)). In addition, the section of the MPEP quoted by applicant further states "However, note that an examiner cannot be expected to foresee whether

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or how an applicant will amend a claim to overcome a rejection except in very limited circumstances (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. 112, second paragraph)".

The examiner provided applicant with a Non-Final Office action, mailed 18 August 2008, in which 35 U.S.C. 112, first paragraph, 35 U.S.C. 102(b), and 35 U.S.C. 103(a) rejections were made. Applicant provided an amendment, filed 18 November 2008, to clearly overcome the rejections made in the amendment that clearly added further limitations to the claims to overcome the existing rejections and that would require further consideration and/or a new search. The examiner properly provided a Final Office action in light of MPEP § 703.07(a), as asserted above. Therefore, the examiner maintains the finality of the Office action, mailed 18 February 2009, as set forth by MPEP § 703.07(a).

17. With respect to applicant's reply/argument that the Information Disclosure Statement, filed 15 April 2009, is not part of a "Request for Continued Examination", the argument is deemed moot since applicant has filed a "Request for Continued Examination" on 15 May 2009.

18. With respect to applicant's reply/argument that the examiner did not provide a *prima facie* case of obviousness, the examiner respectfully disagrees. The examiner provides applicant with a rejection in which Solvinto discloses various elements of the claimed invention. The examiner further provides applicant with certain



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elements/structure/functionality that Solvinto does not disclose (i.e. burning of the skin being prevented by one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected).

In that regard, Solvinto explicitly teaches a clamping blade and a cutting blade. The cutting blade has, thereon, a heating element placed within a slot on the blade itself (page 10, bottom – page 11, line 4). Therefore since Solvinto discloses a cutting blade and a clamping blade with the cutting blade having a heating wire (metallic wire 4) placed at one side of the blade and the clamping blade with the heating wire (metallic wire 4) being situated in the apparatus for explicitly cutting hair which has been heated by the heated wire (metallic wire 4), Solvinto fully meets "at least one blade, placed at one side of the elongated heated wire, the at least one blade being situated and configured to cut the hair which has been heated by the heated wire" given its broadest reasonable interpretation.

Furthermore, the limitation of the wire being positioned "such that it may touch the skin during operation" is being deemed functional language. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In addition, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (see MPEP § 2114). In that regard, Solvinto teaches all the

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structural limitations, as set forth above, and is deemed to have a wire that is positioned on the apparatus in a position that may touch the skin during operation given its broadest reasonable interpretation.

The examiner further cites prior art to Warden et al. to meet the limitations of claims, with respect to the burning of the skin being prevented, as currently recited. The examiner further provides "an exemplary rationale" as set forth in MPEP § 2143 in at least: "Combining prior art elements according to known methods to yield predictable results"; "Use of known technique to improve similar devices (methods, or products) in the same way"; "Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results"; " " Obvious to try " – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success" and "Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention".

Specifically, Warden et al. teach a heating filament (15) in which power is pulsed or supplied for a brief period to heat the heating filament (15). Warden et al. further teach the advantage of such a configuration does not provide discomfort to a patient during use (column 5, lines 10-18), thereby increasing the operational efficiency of the device.

Therefore, it is deemed that the examiner has provided applicant with a *prima facie* case of obviousness, as set forth above and per MPEP § 2143, and the rejections over at least Solvinto in view of Warden et al. stand.

19. In response to applicant's argument that the combination of Solvinto and Warden et al. would result in a device where the preventing feature are not used, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

20. With respect to applicant's reply/argument that the examiner did not provide a *prima facie* case of obviousness, the examiner respectfully disagrees. The examiner provides applicant a rejection in which Iderosa discloses various elements of the claimed invention. The examiner further provides applicant with certain elements/structure/functionality that Iderosa does not disclose (i.e. the wire being heated to a temperature of at least 50°C, a temperature higher than 100°C, a temperature higher than 150°C, a temperature higher than 250°C, a temperature higher than 350°C, a temperature higher than 500°C, or a temperature higher than 700°C; and burning of the skin being prevented by one or more of low mass of the wire, pulsed heating of the wire, heating the wire only when motion is detected and removal of the wire from skin contact when motion is not detected).

The examiner further cites prior art to Solvinto and Ringer et al. to meet the limitations of claims, with respect to temperature, and cites Warden et al., with respect

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to the burning of the skin being prevented, as currently recited. The examiner further provides "an exemplary rationale" as set forth in MPEP § 2143 in at least: "Combining prior art elements according to known methods to yield predictable results"; "Use of known technique to improve similar devices (methods, or products) in the same way"; "Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results"; " " Obvious to try " – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success" and "Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention".

Specifically, Solvinto teaches a cutting apparatus having one blade carrying a metal wire or strip which is heated to a temperature of between 700 and 1000 °C. In addition, Ringler et al. teach a heating element that is heated to a temperature of from about 400 to about 1000°F (equivalency being from about 204.4 to about 537°C) (Abstract; page 2, paragraph 27; page 4, paragraph 48, pages 4-5, claims 2-4, 17-19).

*Ringler et al. further teach the advantage such a configuration provides a means to heating a hair follicle to such a temperature for fusing and sealing the cuticle, cortex and medulla layers of the hair shaft.*

Similarly, Warden et al. teach a heating filament (15) in which power is pulsed or supplied for a brief period to heat the heating filament (15). Warden et al. further teach the advantage of such a configuration does not provide discomfort to a patient during use (column 5, lines 10-18), thereby increasing the operational efficiency of the device.

Therefore, it is deemed that the examiner has provided applicant with a *prima facie* case of obviousness, as set forth above and per MPEP § 2143, and the rejections over at least Iderosa in view of Solvinto, Ringler et al. and Warden et al. stand.

21. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In that regard, the limitation of the wire being positioned “such that it may touch the skin during operation”, the limitation is being deemed functional language. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In addition, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim (see MPEP § 2114). Furthermore, applicant has disclosed that Iderosa is permanently in contact with the skin (page 1; lines 25-28). In that regard, Iderosa teaches all the structural limitations, as set forth above, and is deemed to have a wire that is positioned on the apparatus in a position that may touch the skin during operation given its broadest reasonable interpretation.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHEN J. RALIS whose telephone number is (571)272-6227. The examiner can normally be reached on Monday - Friday, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Stephen J Ralis/  
Examiner, Art Unit 3742

Stephen J Ralis  
Examiner  
Art Unit 3742

SJR  
July 27, 2009